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Trop Pruner & Hu, PC
8554 Katy Freeway
Suite 100
Houston, Texas 77024

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Technology Center 2100

In re Application of: Murthi Nanja)
Application No. 09/778,565)
Filed: February 7, 2001)
For: AGGREGATING WEB DATA ON)
CLIENTS AND DISTRIBUTING THE)
AGGREGATED DATA TO)
WIRELESS HANDHELD DEVICE)

**DECISION ON PETITION
UNDER 37 CFR § 1.181 TO
Invoke SUPERVISORY
AUTHORITY**

This is a decision on the petition under 37 CFR 1.181, filed July 8, 2003 requesting the Group Director to enter an amendment which was refused entry in the Advisory action mailed on June 20, 2003.

- The petition is **DISMISSED**.

CASE HISTORY

An Office action finally rejecting all claims pending in the above-referenced application was mailed on May 21, 2003. Applicant filed a proposed amendment after final (Paper No. 5) on June 12, 2003. The Examiner responded with an Advisory action mailed June 20, 2003 indicating that the proposed amendment after-final would not be entered because it raises New Issues that would require further search and/or consideration.

Petitioner filed the instant petition on July 8, 2003, contending that the proposed amendment should have been entered and requesting withdrawal of the refusal to enter the proposed amendment and that "the amendments to claims 1, 12, and 23 be entered".

OPINION

The relevant section of the MPEP concerning entry of amendments after a final rejection is MPEP § 714.13 which states:

ENTRY NOT A MATTER OF RIGHT

It should be kept in mind that applicant cannot, as a matter of right, amend any finally

rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate previously canceled claims. Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way **requires only a cursory review by the examiner**, compliance with the requirement of a showing under 37 CFR 1.116(b) is expected in all amendments after final rejection.

The newly proposed claims are **not equivalent to any previously presented claims**, but rather they comprise of a claim scope not previously presented. As set forth in the Advisory action, this is the result of applicant's amendment incorporating "detecting the occurrence of a predetermined time", and "automatically transferring" into independent claims 1, 12, and 23 which changes the scope of the claimed invention. Although these claim elements were present in original claims 11 and 22, the selection of these features from claim 11 to amend the independent claim creates new dependent claims which are of a scope not heretofore presented¹.

As set forth above, the amendment clearly fails to simplify the issues, in fact, it raises new issues and would have required further search and/or consideration if entered. As such, the examiner acted properly and within his duties to deny entry of this amendment.

The examiner's refusal to enter the proposed amendment is correct and consistent with Office policy and practice. Accordingly, the Petition to compel the examiner to enter the amendment is **DISMISSED**.

Any request for reconsideration must be filed within two months of the mailing date of this decision.

Pinchus M. Laufer
Pinchus M. Laufer
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security
(703) 306-4160

¹ The amendment must be considered pursuant to MPEP 714.13 and 37 CFR §1.116. That is, if the independent claims in themselves raise no new issues and are now allowable the case should be passed to issue.